

REMARKS**INTRODUCTION**

In accordance with the foregoing, claims 1,10,11, 20, 29, 30, 39, 48, and 49 have been amended. No new matter has been submitted.

Claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 are pending and under consideration.

REQUEST FOR WITHDRAWAL OF FINALITY AND ENTRY OF AMENDMENT

Withdrawal of the finality of the outstanding Office Action is respectfully requested.

In the Response filed November 15, 2004, applicants particularly defined that the previously claimed "electronic mail documents" were not email attachments, but rather "email" themselves. In particular, the Response recited:

"The Office Action appears to be relying on a potential email method of delivery of the different edited versions of the same documents as disclosing the claimed documents being electronic mail documents.

However, in Moody et al., the emailed edited documents would appear to only be attachments to their respective emails. ***The attachments are not electronic mail documents....***

Further, regarding the claimed relevance information being detected by the detector being an 'exchange history of the electronic mail documents,' Moody et al. further fails to disclose this feature.

Any relevance information regarding the documents transported via each email would not have anything to do with the respective emails, but rather would only concern the relevance of the contents of the documents contained in the emails.

Further, any exchange history in Moody et al. *would only concern exchange histories between documents or edits within each document, there would not be any need or desire to maintain an exchange history of the emails that are only used for transporting the respective documents."*

Thus, applicants have particularly defined that the previously claimed electronic mail documents were not attachments to emails, but rather the emails themselves.

Such distinctions and definitions by applicants **must** be given consideration in

interpreting the claims.

However, the outstanding Office Action has again repeated the previous rejections without taking the applicant supplied distinction and definition into consideration.

As recently reconfirmed in *Philips v. AWH Corp.*, 75 USPQ2d 1321 (CA FC 2005), the prosecution history and specification **must** be considered when interpreting claim terms.

If applicant specification distinguishes a claims term from an interpretation presented in an Office Action and if that distinction and/or definition are consistent with the specification, then the Examiner **must** consider that distinction and/or definition in interpreting the claims term.

Further, *Honeywell Inc. v. Victor Co. of Japan Ltd.*, 63 USPQ2d 1904 (CA FC 2002) "It is well settled that a patentee may define a claim term either in the written description of the patent or, as in the present case, in the prosecution history. *Mycogen Plant Science v. Monsanto Co.*, 243 F.3d 1316, 1327, 58 USPQ2d 1030, 1039 (Fed. Cir. 2001). Frequently, a definition offered during prosecution is made in response to a rejection, and is entered in conjunction with a narrowing amendment. See, e.g., *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1677 (Fed. Cir. 1995). **Such a definition limits the scope of the claim, preventing the patentee from later recapturing what was previously surrendered. Although the inventor's definition does not have a narrowing effect, it is nonetheless relevant in indicating the meaning that the inventor ascribed to the term.** See *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996).

Thus, in the last Response applicants particularly distinguished the claimed electronic mail document from the Office Action interpreted attachment, and further defined the electronic mail document as being consistent with an email, i.e., not just email attachments.

Conversely, the Office Action has maintained an improper interpretation of the claimed document as potentially being the attachments to emails, and further argues that the cited reference's manipulation, relevance review, and exchange history of such attachments meets the claimed relevance and exchange history of 'documents.'

However, since the claimed 'documents' **cannot** be interpreted as merely the attachments, they cannot be interpreted as corresponding to any manipulation, relevance review, or exchange history of such attachments.

Accordingly, it is respectfully submitted that the outstanding Office Action is improper for failing to properly interpret the claimed documents. Further, based on this improper

interpretation of the claimed documents, it is respectfully requested that the finality of the outstanding Office Action be withdrawn.

To further emphasize the aforementioned definition presented in the last Response, applicants have accordingly incorporated the same into the pending claims, emphasizing that the claimed 'documents' are 'electronic mail,' rather the apparent misinterpreted 'electronic mail documents.'

As this distinction and definition has previously been presented in the last Response, and should have been utilized in interpreting the claimed documents, the above amendments to the claims do not change the scope or breadth of the claims.

Further, such amendments cannot be considered to substantively change the pending claims, i.e., no new issues have been raised and no additional search will be required.

Therefore, in addition to aforementioned request for withdrawal of the finality of the outstanding Office Action, it is respectfully requested that this After Final Amendment also be entered and reconsideration given to the allowability of the claims.

REJECTION UNDER 35 USC 102

The Examiner rejected claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 under 35 U.S.C. 102(b) as being anticipated by Moody et al (USP 5,890,177). This rejection is again respectfully traversed.

It is respectfully submitted that Moody et al. at least fails to disclose the presently claimed documents being electronic mail and/or the claimed relevance information being detected by the detector being an "exchange history of the electronic mail."

Again, it is respectfully noted that Moody et al. only sets forth a document collection method of collecting different edited versions of the same document and combining all the different edits from each edited document into a single document. In Moody et al., many different people can work on the same document, make their individual edits to the document, and then the differently edited documents can be collected, and different edits may potentially then be automatically merged into a single document or the different edits illustrated on the same screen for a user to approve of the same.

The following is again noted:

In Moody et al., emailed edited documents would appear to only be attachments to their respective emails. As noted above, and pointed out in the previous Response, the attachments

are not electronic mail documents.

In additions, Moody et al. would appear to remove the email attachments, convert each document into the proper format, and then evaluate the edits within each document. At this point, the illustrated edits are definitely not electronic mail. The illustrated edits are merely portions of documents resident on the ultimate primary user's computer.

Thus, in Moody et al., the use of email is only a mechanism for transporting documents. Once the documents are received at an ultimate primary user's computer (or center combining location) the documents are removed from the emails and are no longer associated with the same. Further, when the formats of each document are modified, the reformatted documents are even different from the documents forwarded with the email.

Further, regarding the claimed relevance information being detected by the detector being an "exchange history of the electronic mail," Moody et al. further fails to disclose this feature.

Any relevance information regarding the documents transported via each email would not have anything to do with the respective emails, but rather would only concern the relevance of the contents of the documents contained in the emails.

Further, any exchange history in Moody et al. would only concern exchange histories between documents or edits within each document, there would not be any need or desire to maintain an exchange history of the emails that are only used for transporting the respective documents.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 be withdrawn and claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 be allowed.

CONCLUSION

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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